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NIRO, SCAVONE, HALLER & NIRO			EXAMINER	
181 W. MADISON			CALDWELL, ANDREW T	
SUITE 4600				
CHICAGO, IL 60602			ART UNIT	PAPER NUMBER
			2142	
			MAIL DATE	DELIVERY MODE
			02/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Communication Re: Appeal

Application No.

10/029,483

Examiner

Andrew Caldwell

Applicant(s)

BERIKER, JAMES

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☐ The Notice of Appeal filed on _____ is not acceptable because:

- (a) ☐ it was not timely filed.
- (b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 41.20(b)(1).
- (c) ☐ the appeal fee received on _____ was not timely filed.
- (d) ☐ the submitted fee of \$_____ is insufficient. The appeal fee required by 37 CFR 41.20(b)(1) is \$_____.
- (e) ☐ the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected.
- (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on _____.

2. ☐ The appeal brief filed on _____ is NOT acceptable for the reason(s) indicated below:

- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 41.37(a).
- (b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 41.20(b)(2).
- (c) ☐ the submitted brief fee of \$_____ is insufficient. The brief fee required by 37 CFR 41.20(b)(2) is \$_____.

The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. See 37 CFR 41.37(a)(1). Extensions of time may be obtained under 37 CFR 1.136(a). See 37 CFR 41.37(e).

3. ☒ The appeal in this application is DISMISSED because:

- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 41.20(b)(2) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (b) ☐ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (c) ☐ a Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on _____.
- (d) ☒ other: see attached.

4. ☒ Because of the dismissal of the appeal, this application:

- (a) ☒ is abandoned because there are no allowed claims.
- (b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
- (c) ☐ is before the examiner for consideration.



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER

Attachment to PTOL-461

This appeal is dismissed because the applicants did not file an amended brief that overcomes all the reasons for noncompliance for which the appellant was notified on June 4, 2007. See MPEP 1205.03.

On June 4, 2007, the Office mailed a notice of non-compliant appeal brief holding as defective the appeal brief filed on January 16, 2007. The notice of non-compliant appeal brief identified various defects in the brief, including the failure of the applicants to *identify* the structure that corresponds to the means for establishing an account.

In the original defective appeal brief filed on January 16, 2007, the applicants attempted to comply with the requirement of 37 CFR 41.37 (c)(1)(v) by including the following text in order to identify the structure corresponding to the means for establishing an account:

The system of claim 1 further comprises a means for establishing an account for the referral provider, wherein the account includes an account name, a unique identification and a password. This element is a means plus function element, with structure corresponding to the claim element found in the specification, for example at Figure 2 and page 6, line 23, to about page 7, line 6 (discussing the 'Set up Account' button, 'or any other interface that may be suitable').

In the notice, the Examiner explained how the cited portions of the figures and specification all referred to various structures involved in the establishment of an account. The Examiner then explained how it was unclear how much of the structure

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was intended to correspond to the "means" in claim 1. The Examiner required the applicants to *clearly identify* the structure that performs the function in their response to the notice of non-compliant appeal brief.

In the appeal brief filed on October 5, 2007, the applicants attempted to comply with the requirement of 37 CFR 41.37 (c)(1)(v) by including the following text in order to identify the structure corresponding to the means for establishing an account:

The system of claim 1 further comprises a means for establishing an account for the referral provider, wherein the account includes an account name, a unique identification and a password. This element is a means plus function element, with structure corresponding to the claim element found in the specification, for example at Figure 2 and page 6, line 23, to about page 7, line 6 (discussing the 'Set up Account' button, 'or any other interface that may be suitable').

This text is identical to what was submitted in the appeal brief filed on January 16, 2007. See above. The cited portion of the appeal brief raises the same questions as to the structure corresponding to the means for establishing an account as it did when it was included in the appeal brief filed on January 16, 2007.

After including all information that was in the original defective brief's summary of claimed subject matter with respect to the means for establishing account, the revised appeal brief of October 5, 2007 included a new section called "Reference to line numbers for independent claims." In this new section, the applicants included the following additional information with respect to the means for establishing an account:

means for establishing an account for the referral provider ([0035]), wherein the account includes an account name, a unique identification and a password (original claim 1, [0026]);
at least one traffic management parameter ([0026]); and
a search referral module ([0038]), wherein the search referral module analyzes the user computer's search request ([0036]).

Defined structure for: "means for establishing an account" Structure defined in [0026] including computer running "traffic management system" (Fig. 1, (28) including structure in [0024])

See page 8 of appeal brief filed October 5, 2007.

In a side comment related to the format of the portion of the brief shown above, the applicants are reminded that a reference in an appeal brief to a paragraph number of a published patent application publication is improper unless the paragraph numbering of the patent application publication and the specification of the actual application are the same. In this case, the paragraphs of the specification are not numbered as required by 37 CFR 1.52(a)(6), so the paragraphs in the specification cannot have the same numbering as the patent application publication 2002/0091879. Accordingly, the applicants cannot use paragraph numbers and must refer to the specification by page and line number as specified in 37 CFR 41.37 (c)(1)(v). For this reason, the appeal brief does not comply with 37 CFR 41.37(c)(1)(v).

The newly added section to the summary of the claimed subject matter in the appeal brief filed on October 5, 2007 does not identify the structure that corresponds to the means for establishing an account. This explanation will address the two relevant parts of the newly added material. First, the portion of the summary of the claimed subject matter, reproduced above, that shows a mapping of the claim language to the

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reference will be discussed. Second, the section beginning "Defined structure for:" will be discussed.

As to the first section, which maps the patent application publication to the claim language, nothing in the newly added material identifies the structure that corresponds to the means for establishing an account. First, the applicants cite paragraph 35 of patent application publication 2002/0091879 (specification page 9 lines 6-9). This paragraph describes what happens *after* a referral provider has set up an account. The examiner fails to see how this portion of the specification describing what happens *after* an account is set up is germane to the structure that sets up the account. Then the applicants cite original claim 1. The examiner fails to see how citing a portion of the application that merely repeats the means plus function limitation at issue is helpful. Finally, the applicants point to paragraph 26 of patent application publication 2002/0091879. This paragraph of the patent application corresponds to specification page 6 line 23 to page 7 line 7. This text is identical to what was cited in the defective appeal brief filed on January 16, 2007. The cited material raises the same questions as to the structure corresponding to the means for establishing an account as it did when it was included in the appeal brief filed on January 16, 2007. The examiner fails to see how repeating citations yet again to the same defective sections of the specification addresses the issues raised in the notice of non-compliant appeal brief mailed on June 4, 2007. In conclusion, the examiner fails to see how this section of the newly added material identifies the structure that corresponds to the means for establishing an account.

As to the second section, beginning with the label "Defined structure for:," nothing in the newly added material identifies the structure that corresponds to the means for establishing an account. First, the applicants say that the means corresponds to the structure defined in paragraph 26 of patent application publication 2002/0091879. The reasons why paragraph 26 does not identify the structure corresponding to the means for establishing an account are addressed above. The applicants then go on to say "the structure *including* [emphasis added] computer running traffic management system (Fig. 1, 28 including structure in [0024])." This statement does not identify the structure corresponding to the means for establishing an account for a number of reasons. First, assuming that the computer running the traffic management system is the structure, the applicants have deliberately chosen to use open ended language (i.e., the word including). This use of open ended language suggests that other structure, in addition to the traffic management system, could be involved in establishing an account. 37 CFR 41.37(c)(1)(v) requires the applicants to identify *the* structure, not *some* of the structure. The examiner sees no reason why the applicants should not provide a clear identification of the structure so that the Board of Patent Appeals and Interferences can determine the metes and bounds of the limitation at issue. Second, assuming that the applicants are pointing to the traffic management system as the structure corresponding to the means for establishing an account, it is clear based on the claim language that the means for establishing an account is not the *entire* traffic management system. The preamble of the claim refers to a traffic management system. If the applicants intended the structure that corresponds to the

means for establishing an account to be the entire traffic management system, the applicants would not have used different language (i.e., a means plus function limitation) to refer to that structure. The applicants would merely have referred to the traffic management system itself. The applicants, based on the claim language, are attempting to claim some piece of the traffic management system, and it is incumbent on the applicants to clearly identify what that piece is. The applicants also point to paragraph 24 of patent application publication 2002/0091879 corresponding to specification page 6 lines 12-19. The section of the specification merely describes how the entire traffic management system is a computer. The examiner fails to see how this section of the specification identifies a structure corresponding to the means for establishing an account. In conclusion, nothing in this newly added portion of the appeal brief identifies the structure corresponding to the means for establishing an account and the appeal brief filed on October 5, 2007 is therefore defective.

The notice of non-compliant appeal brief mailed on June 4, 2007 identified an additional problem with the appeal brief filed on January 16, 2007. Claim 1 includes the limitation of a search referral module that analyzes the user computer's search request. In the June 4, 2007 notice, the examiner explained why the specification does not describe a search referral module that analyzes a user computer's search request. The portions of the specification cited by the applicant in the appeal brief filed on January 16, 2007 describe a *keyterm search analyzer* that analyzes a user's search request but not a *search referral module* that performs this function. The specification describes a keyterm search analyzer is distinct from the search referral module. An appeal brief

that points to something other than what is claimed as support for the thing that is claimed cannot comply with the requirements of 37 CFR 41.37(c)(1)(v). It is noted that the only portion of the application as originally filed that describes a search referral module that analyzes a user computer's search request is the original claims.

The appeal brief filed on October 5, 2007 did nothing to correct the defect identified by the examiner in the notice of non-compliant appeal brief mailed on June 4, 2007. On page 3 of the appeal brief at lines 4-6, the applicants repeated the exact same language that appears in the summary of the claimed subject matter on page 3 lines 6-8 of the appeal brief filed on January 16, 2007. The applicants then cited new material, particularly paragraphs 36 and 38 of patent application publication 2002/0091879. The newly cited material corresponds to specification page 9 lines 10-22 and page 9 line 27 to page 10 line 14. These newly cited portions of the specification do not address the issues raised by the examiner. The specification describes at page 10 lines 2-4 how a search referral module may be incorporated into a search analyzer (i.e., the keyterm search analyzer discussed in the June 4, 2007 notice). The language of this portion of the specification makes clear that the thing that results from the incorporation of a search referral module into a search analyzer is a search analyzer and not a search referral module. The claim appears to be directed to the opposite. Accordingly, the appeal brief is still defective because it does not refer to the specification by page and line number to describe the subject matter defined in the claim.